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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,731	11/13/2001	Roswell R. Roberts III	12984US02	1732
7590 11/17/2005 McAndrews, Held & Malloy, Ltd. 500 W. Madison Street, 34th Floor Chicago, IL 60661			EXAMINER POKRZYWA, JOSEPH R	
			ART UNIT 2622	PAPER NUMBER

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/990,731	Applicant(s) ROBERTS ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-27 is/are pending in the application.
 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/22/02 & 3/20/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Status of Claims

1. The examiner notes that, as originally filed, no **claim 13** was present in the application. Thus, **claim 13** will be treated as a canceled claim number.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claims 1-12, 14-19, and 21-27**, drawn to a satellite-based facsimile distribution system, classified in class 358, subclass 1.15.
 - II. **Claim 20**, drawn to an Ethernet Digital Storage Card, classified in class 711, subclass 115.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, the invention of Group I has separate utility, such as a system that transmits facsimile data via a satellite, while the invention of Group II has a utility, such as a memory card that stores a portion of a received document. See MPEP § 806.05(d).
4. During a telephone conversation with Joseph Barich on Wednesday, November 9, 2005, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-12, 14-19, and 21-27. Affirmation of this election must be made by applicant in replying to this

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Office action. Claim 20 is withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

6. The references listed in the Information Disclosure Statements submitted on 11/22/02 and 3/20/03 have been considered by the examiner (see attached PTO-1449's).

Drawings

7. The drawings were received on 4/4/02. These drawings are acceptable by the examiner.

Claim Objections

8. **Claims 3 and 23** are objected to because of the following informalities:

in **claims 3 and 23**, line 1 in both claims, "wherein said recipient information" should be changed to read "wherein recipient information", **OR** the dependency should be changed in both claims so that the to reference to "said recipient information" is previously introduced.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-3, 8, 9, 15, 16, and 21-23** are rejected under 35 U.S.C. 102(b) as being anticipated by Shiraogawa *et al.* (U.S. Patent Number 5,343,305).

Regarding **claim 1**, Shiraogawa discloses a satellite-based fax distribution system (see Fig. 1) including a producer receiving a document to be faxed and traffic instructions for the document (multiple addressing station 20, column 5, lines 9-39), the producer determining an affiliate based on the traffic instructions and directing the document to the affiliate through the satellite (column 5, lines 19-column 6, line 24), a satellite receiving the document from the producer and transmitting the document to the affiliate (satellite 50, column 5, lines 9-18), and an affiliate receiving the document (terminal station 40a-40b, column 6, lines 37-64) and faxing the document to a recipient (receiving facsimile device 30, column 3, lines 15-47, and column 6, lines 37-64).

Regarding **claim 2**, Shiraogawa discloses the system discussed above in claim 1, and further teaches that the traffic instructions include recipient information identifying the recipient (column 5, lines 19-column 6, line 24).

Regarding **claim 3**, Shiraogawa discloses the system discussed above in claim 1, and further teaches that the recipient information is sent to the affiliate (column 5, lines 19-column 6, line 24).

Regarding **claim 8**, Shiraogawa discloses a method for distributing faxes via a satellite-based fax distribution system (column 5, lines 9-39), the method including receiving a document to be faxed (at the multiple addressing station 20, column 5, lines 9-39), receiving traffic instructions regarding the document (column 5, lines 9-39), determining an affiliate based on the traffic instructions at a producer (column 5, line 19-column 6, line 24), directing the document to the affiliate through a satellite (column 5, lines 19-column 6, line 24), receiving the document at the affiliate (being the terminal station 40a-40b, column 6, lines 37-64), and faxing the document from the affiliate to a recipient (being the receiving facsimile device 30, column 3, lines 15-47, and column 6, lines 37-64).

Regarding **claim 9**, Shiraogawa discloses the method discussed above in claim 8, and further teaches that the traffic instructions include recipient information identifying the recipient and the recipient information is sent to the affiliate (column 5, lines 19-column 6, line 24).

Regarding **claim 15**, Shiraogawa discloses an affiliate (terminal station 40a-40b, column 6, lines 37-64) in a satellite-based fax distribution system (see Fig. 1), the affiliate including a receiver for receiving a document from a producer over a satellite communication link (column 5, lines 9-54, and column 6, lines 18-54), the document routed from the producer to the receiver by traffic instructions (column 5, line 19-column 6, line 24), a fax system for faxing the document to a recipient (receiving facsimile device 30, column 3, lines 15-47, and column 6, line 37-column 7, line 8).

Regarding **claim 16**, Shiraogawa discloses the affiliate discussed above in claim 15, and further teaches that the traffic instructions include recipient information identifying the recipient and the recipient information is sent to the affiliate (column 5, lines 19-column 6, line 24).

Regarding **claim 21**, Shiraogawa discloses a satellite-based fax distribution system (see Fig. 1) including a producer in communication with a satellite (multiple addressing station 20, column 5, lines 9-39), the producer receiving a document to be faxed and traffic instructions for the document (column 5, lines 19-column 6, line 24), the producer determining a plurality of remote affiliates based on the traffic instructions and directing the document to the plurality of remote affiliates through the satellite (column 5, lines 19-column 6, line 24, and column 7, lines 31-48), a satellite receiving the document from the producer and transmitting the document to the plurality of remote affiliates (satellite 50, column 5, lines 9-18), and a plurality of remote affiliates (terminal stations 40a-40b, column 6, lines 37-64), whereby the plurality of remote affiliates receive the document from the satellite (column 6, lines 37-64, and column 7, lines 31-48), and whereby the plurality of remote affiliates faxes the document to a plurality of remote recipients (receiving facsimile device 30, column 3, lines 15-47, and column 6, lines 37-64).

Regarding **claim 22**, Shiraogawa discloses the system discussed above in claim 21, and further teaches that the traffic instructions include recipient information identifying the plurality of remote recipients (column 5, lines 19-column 6, line 24).

Regarding **claim 23**, Shiraogawa discloses the system discussed above in claim 21, and further teaches that the recipient information is sent to the plurality of remote affiliates (column 5, lines 19-column 6, line 24).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 4-7, 10-12, 14, 17-19, and 24-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiraogawa *et al.* (U.S. Patent Number 5,343,305) in view of Shi *et al.* (U.S. Patent Number 6,411,689).

Regarding **claims 4, 10, and 24**, Shiraogawa discloses the systems and method discussed above in claims 1, 8, and 21, respectively, but does not expressly disclose if the producer receives the document from a virtual fax print driver.

Shi discloses a satellite-based fax distribution system (see Fig. 2) including a producer receiving a document to be faxed and traffic instructions (being the DIS signals) for the document (intelligent fax relay 16, column 4, lines 4-39, and column 5, line 45-column 6, line 51), the producer directing the document to the affiliate through the satellite (base station 20, and column 5, line 45-column 6, line 51), a satellite receiving the document from the producer and transmitting the document to the affiliate (see Fig. 2), and an affiliate receiving the document (base station 20) and faxing the document to a recipient (fax 24, column 6, lines 24-64). Further, Shi teaches that the producer receives the document from a virtual fax print driver (being inherent in the laptop computer 30, column 4, lines 4-29).

Shiraogawa and Shi are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over a satellite link. At the time of the invention, it

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would have been obvious to a person of ordinary skill in the art to incorporate Shi's teachings in the system of Shiraogawa. The suggestion/motivation for doing so would have been that that the system of Shiraogawa would become usable by more users, as facsimile data can be transmitted from both facsimile machines and virtual fax drivers, as recognized by Shi in column 4, lines 8-13. Therefore, it would have been obvious to combine Shi's teachings with the system of Shiraogawa to obtain the invention as specified in claims 4, 10, and 24.

Regarding *claims 5, 6, 11, 12, 17, 18, 25, and 26*, Shiraogawa discloses the systems, method, and affiliate discussed above in claims 1, 8, 15, and 21, respectively, but fails to expressly disclose if affiliate includes a memory for storing the document or if the affiliate stores information concerning the document.

Shi discloses a satellite-based fax distribution system (see Fig. 2) including a producer receiving a document to be faxed and traffic instructions (being the DIS signals) for the document (intelligent fax relay 16, column 4, lines 4-39, and column 5, line 45-column 6, line 51), the producer directing the document to the affiliate through the satellite (base station 20, and column 5, line 45-column 6, line 51), a satellite receiving the document from the producer and transmitting the document to the affiliate (see Fig. 2), and an affiliate receiving the document (base station 20) and faxing the document to a recipient (fax 24, column 6, lines 24-64). Further, Shi teaches that the affiliate includes a memory for storing the document (column 6, lines 48-63), and that the affiliate stores information concerning the document (column 4, lines 40-57).

Shiraogawa and Shi are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over a satellite link. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Shi's teachings in

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the system of Shiraogawa. The suggestion/motivation for doing so would have been that the system of Shiraogawa would conform to well-known standards in wirelessly receiving facsimile data and forwarding the data over a PSTN, since the facsimile data would need to be stored to accommodate for delays between the two networks, as recognized by Shi in column 5, line 13-column 6, line 22. Therefore, it would have been obvious to combine Shi's teachings with the system of Shiraogawa to obtain the invention as specified in claims 5, 6, 11, 12, 17, 18, 25, and 26.

Regarding *claims 7, 14, 19, and 27*, Shiraogawa discloses the systems, method, and affiliate discussed above in claims 1, 8, 15, and 21, respectively, but fails to expressly disclose if the affiliate notifies the producer of the status of the document received by the affiliate.

Shi discloses a satellite-based fax distribution system (see Fig. 2) including a producer receiving a document to be faxed and traffic instructions (being the DIS signals) for the document (intelligent fax relay 16, column 4, lines 4-39, and column 5, line 45-column 6, line 51), the producer directing the document to the affiliate through the satellite (base station 20, and column 5, line 45-column 6, line 51), a satellite receiving the document from the producer and transmitting the document to the affiliate (see Fig. 2), and an affiliate receiving the document (base station 20) and faxing the document to a recipient (fax 24, column 6, lines 24-64). Further, Shi teaches that the affiliate notifies the producer of the status of the document received by the affiliate (column 4, lines 40-57, and column 5, lines 36-44).

Shiraogawa and Shi are combinable because they are from the same field of endeavor, being systems that transmit facsimile data over a satellite link. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate Shi's teachings in

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the system of Shiraogawa. The suggestion/motivation for doing so would have been that that the system of Shiraogawa would conform to well-known standards in facsimile protocol, as a receipt confirmation is inherently transmitted within the T.30 facsimile messages, as recognized by Shi in column 5, line 13-column 6, line 22. Therefore, it would have been obvious to combine Shi's teachings with the system of Shiraogawa to obtain the invention as specified in claims 7, 14, 19, and 27.

Citation of Pertinent Prior Art

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bond (U.S. Patent Number 3,594,495) discloses a radio facsimile postal system; and

Feldman (U.S. Patent Number 5,587,810) discloses a system for transmitting facsimile data by satellite.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

A handwritten signature in cursive script, appearing to read "Joseph R. Pokrzywa".

jrp